

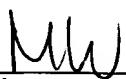


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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/451,160 | 11/30/1999 | STEVEN R. BOAL | 80.142-002 | 8692 |
| 7590 | 05/11/2004 | | EXAMINER | |
| RONALD P. KANANEN, ESQ RADER, FISHMAN & GRAUER P.L.L.C. 1233 20TH STREET N.W. SUITE 501 WASHINGTON, DC 20036 | | | MYHRE, JAMES W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |
| | | | DATE MAILED: 05/11/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|--|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/451,160 | BOAL, STEVEN R.  | |
| | Examiner | Art Unit | |
| | James W Myhre | 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 and 22-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 and 22-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on February 4, 2004, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 26, 28, 30-32, and 44 rejected under 35 U.S.C. 102(e) as being anticipated by Philyaw et al (6,377,986).

Claims 26 and 44: Philyaw discloses a system and method for distributing coupons, comprising:

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- a. collecting device information about a client device (col 19, lines 11-60);
- b. associating a device ID with the device information at a main server (col 19, lines 11-60);
- c. selecting a coupon according to the device ID based on the device information (col 19, lines 11-60); and transmitting the selected coupon to the client system (col 19, lines 11-60).

While, as the Applicant pointed out (page 19), Philyaw indicates in column 19, lines 34-35 that the user ID 1806 identifies the user, the Examiner notes that Philyaw explicitly discloses "a user ID which identifies the user location of the wand 1600" (col 17, lines 3-4); "also provides a unique user ID for establishing the location of the user of the wand 1606" (col 17, lines 60-61); "the wand ID 1804 which is embedded in a memory in the wand 1600 and identifies it with a particular wand distributor; and a user ID 1806 which is derived from the software running on the PC 302 and which identifies uniquely with the user location" (col 19, lines 16-20); and that "if it is known that a particular wand 1600 is sold in a certain geographic area, this information can be useful in targeting the particular user with certain advertising information relevant to that geographic area" (col 19, lines 48-52). Thus, while Philyaw may make one statement that the user ID identifies the particular user, throughout most of the disclosure the user ID only identifies the location of the user of the wand. Therefore, the system is receiving device information (wand ID) from a device of a client system without obtaining information sufficient to specifically identify the user, except for the general geographic location of the user, which again is based on the geographic location in

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which the wand was sold. The Examiner notes that in one further embodiment Philyaw does discuss collecting demographic data from the user to generate a user profile for use in a more precise targeting of advertisements. However, this is an additional embodiment and is not mentioned until column 20 of the specification and is not present in either of the independent claims nor in most of the dependent claims.

Claim 28: Philyaw discloses a method for distributing coupons as in Claim 26 above, and further discloses associating the device ID with a remote client system (col 19, lines 11-60).

Claim 30: Philyaw discloses a method for distributing coupons as in Claim 28 above, and further discloses the client system submitting a request including the device ID to the server (col 19, lines 11-60).

Claim 31: Philyaw discloses a method for distributing coupons as in Claim 30 above, and further discloses automatically including the device ID without intervention by the remote user (col 19, lines 11-60).

Claim 32: Philyaw discloses a method for distributing coupons as in Claim 30 above, and further discloses the request is automatically transmitted without intervention by the user (col 19, lines 11-60).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al (6,298,446) in view of Mankoff (6,385,591).

Claim 24: Schreiber discloses a method for distributing and redeeming coupons, comprising:

- a. associating a Uniform Resource Locator (URL)(i.e. network address) with a coupon (digital image)(col 6, lines 37-41 and col 32, line 65 – col 33, line 30);
 - b. displaying the coupon to a user (col 6, line 58 – col 7, line 65);
 - c. disabling access to the URL by the user (col 6, line 58 – col 7, line 65);

and

- d. invoking (accessing) the URL with a browser to enable the user to redeem the coupon (col 32, line 65 – col 33, line 30).

While Schreiber discloses that the digital image being accessed by the user can be used in electronic commerce (col 33, lines 16-30), it is not explicitly disclosed that the digital image is a coupon. The Examiner notes that the claim does not actually use the coupon, but merely indicates that the final step of invoking the URL with a browser will “enable the user to redeem the coupon”. The Examiner considers this as the intended use of the invention, since no steps are shown in which the user actually redeems the coupon. Therefore, since the digital image data does not perform any functions in this claim, little, if any, patentable weight is given to the type of information

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contained in the digital image. Furthermore, Mankoff discloses a similar method for distributing and redeeming coupons online in which the online coupon is a digital image (col 1, lines 47-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the digital images in Schreiber being used in electronic commerce would include one or more of such electronic commerce image files as coupons, rebate forms, order forms, product images, etc. One would have been motivated to include a coupon as one type of digital image being protected by Schreiber in order to provide better control of the coupon by the issuer, e.g. limiting one to a customer, demographic tracking of who was receiving the coupon and who was redeeming the coupon, limiting liability (staying within advertising budget), etc. as is common in the marketing industry and described in Mankoff (col 14-17).

Schreiber explicitly discloses at least two method of disabling access to the URL by the user. Schreiber discloses that "Most web browsers enable a user to view the source for the web page being displayed...by right-clicking on such an image" (col 6, lines 58-63). The Applicant also discusses in the present arguments that "the specified URL (and code) is neither displayed nor available, and cannot be discovered by, for example, right-clicking on coupon display 76" (page 12). Thus, both Schreiber and the Applicant are in agreement that a user can access the URL by right-clicking on the image. However, Schreiber also discloses (as the Applicant noted on page 15) that it was known in prior art to "use Java applets within web browsers to disable the menu that pops up when a user right clicks on a displayed image within his browser" (col 2, lines 37-40); thus, disabling the display and access to the URL by the user. Schreiber

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further prevents the user from discovering the URL of the actual digital image by substituting an alias URL into the digital image being downloaded to the user computer and states "in order to protect image 904 from unauthorized access, the reference in web page 902 to image 904 is done through an alias 908. That is reference does not specify the IP address and tile file name of image 904; instead, it specifies an alias 908, which only server computer 900 can interpret" (col 20, lines 35-40). Thus, Schreiber discloses disabling the user's access to the URL of the coupon (digital image) by either substituting a different menu for the normal menu displayed when the user right-clicks on the image or by substituting a different URL which only the server computer can interpret.

Claim 25: Schreiber and Mankoff disclose a method for distributing and redeeming coupons as in Claim 24 above, and Schreiber further discloses selecting the coupon by clicking on the coupon (digital image)(col 33, lines 16-30).

5. Claims 1-18, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al (6,298,446) in view of Mankoff et al (6,385,591) and in further view of Philyaw et al (6,377,986).

6. Claims 27, 29, 33-43, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Philyaw et al (6,377,986) in view of Schreiber et al (6,298,446) and Mankoff et al (6,385,591).

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The Examiner notes that the claim set contains two inventions. Independent Claim 24 is directed towards a method of disabling access to a link prior to redeeming a coupon. Independent Claim 26 is directed towards a method of selecting a targeted coupon based on the client device's information and ID. Claims 1 and 22 add the targeting method steps of Claim 26 to the access disabling and redemption steps of Claim 24. The two inventions are further limited by matching dependent claims. In order to compress prosecution of the pending claims, the Examiner will group the rejections of these matching dependent claims together.

The Examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the references. One would have been motivated to include Philyaw's method of selecting targeted coupons with Schreiber and Mankoff's method of disabling access to a link prior to redeeming the coupon or to include Schreiber and Mankoff's method of disabling access to a link prior to redeeming a coupon with Philyaw's method of selecting targeted coupons in order to have a complete coupon processing system in which targeted coupons are selected, issued, protected, and then redeemed by accessing a link whose access had been disabled.

Claim 1: Schreiber and Mankoff disclose a method for distributing and redeeming coupons as in Claim 24 above, but do not explicitly disclose the steps of selecting a targeted coupon based on the device ID and information as in Claim 26. However, as discussed above, Philyaw discloses these steps. Therefore, it would have been obvious to include the targeted coupon selection and issuance method of Philyaw to

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Schreiber and Mankoff's redemption method. One would have been motivated to include the selection and issuance steps in order to have coupons to redeem.

Claims 2, 27, 45, and 46: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 1, 26, and 44 above. Mankoff further discloses obtaining demographic information including an address, web site URL, map, email address, etc. (col 1, lines 50-58). In the United States, it is required by the United States Postal Service that all addresses have a zip code. Therefore, based on Mankoff's disclosure of collecting address information when taken along with Schreiber's disclosure of using the digital image in an electronic transaction for purchasing clothing (which would require sending the purchased clothing to the user) and Philyaw's disclosure of the User ID identifying the location of the user, plus in one embodiment also collecting demographic information about the user, it would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain demographic information to include a postal zip code from the user of the client device in Schreiber or Philyaw. One would have been motivated to obtain this information in order to allow the systems to better target the selection of the coupon for redemption at local merchants and to enable the system to mail additional information (e.g. more coupons or the actual product) to the user as discussed in Schreiber.

Claim 3: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 1 above, and Philyaw further discloses associating the device ID with a remote client system (col 19, lines 11-60).

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Claims 4 and 29: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3 and 28 above, and Schreiber also discloses several methods for printing an unencrypted file (coupon). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the coupon at the client device. One would have been motivated to print the coupon in order to allow the user of the device to redeem the coupon at a "brick-and-mortar" store.

Claim 5: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 3 above, and Philyaw further discloses the client system submitting a request including the device ID to the server (col 19, lines 11-60).

Claim 6: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 5 above, and Philyaw further discloses automatically including the device ID without intervention by the remote user (col 19, lines 11-60).

Claim 7: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 5 above, and Philyaw further discloses the request is automatically transmitted without intervention by the remote user (col 19, lines 11-60).

Claims 8 and 33: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 7 and 32 above, and Philyaw further discloses the transmitting step occurs at predetermined intervals (update process)(col 7, lines 51-65).

Claims 9, 10, 34, and 35: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3 and 28 above, but none of the references explicitly disclose that the graphical user interface on the client device uses icons which may also flash to indicate the availability of new coupons. However, Official Notice is again taken that the use of icons, graphics, colors, animation, etc. to attract the viewer's attention on graphical user interfaces is well known in the computer arts, and their use would have been obvious to one having ordinary skill in the art at the time the invention was made. In support of this Official Notice, the Examiner is providing excerpts from two HTML textbooks from 1996 to show that, not only was it well known to "flash" parts of a web page to attract the user's attention, but that the "Blink" command was also one of the standard commands in the programming language (Graham, "The HTML Sourcebook, Second Edition, A Complete Guide of HTML 3.0", 1996, pp 233-234)(Lemay, "Teach Yourself Web Publishing with HTML 3.0 in a Week", 1996, pp 183). Therefore, one would have been motivated to use icons, flashing or otherwise, to notify the user of the Schreiber and Philyaw systems in order to attract their attention more easily.

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Claims 11, 22, and 36: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3, 24, 26, and 28 above, and Schreiber further discloses encrypting the coupon data at the server prior to sending the coupon to the client system (col 28, lines 43-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include encryption techniques in the Philyaw system. One would have been motivated to encrypt the coupon data prior to transmitting the data over an unsecure network, such as the Internet as disclosed by Philyaw, in order to prevent unauthorized interception of the data.

Claims 12 and 37: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 11 and 36 above. While none of the references explicitly disclose that the client system will also encrypt the coupon data upon receiving the data from the remote server, Official Notice is again taken that it is old and well known within the data encryption arts to encrypt data using a plurality of encryption methods in order to provide a higher level of security to the data. In support of this Official Notice, the Examiner is providing Chapter 15 from a cryptography textbook from 1996 to show that not only was double encryption a well known method to further protect data, but triple encryption and other multiple encryption schemes were also well known and used in the art (Schneier, "Applied Cryptography, Second Edition", 1996, pp 357-368). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a local encryption method to further encrypt and protect the encrypted data received from the

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remote server. One would have been motivated to further encrypt the coupon data locally in this manner in order to prevent unauthorized disclosure of the selected coupons to other persons who may use the client device (e.g. other family members, co-workers, etc.).

Claims 13, 23, and 38: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 12, 22, and 37 above, and Schreiber further discloses the client device decrypting and printing the coupon (col 28, lines 50-52). The Examiner notes the Schreiber discloses several well known methods for printing unencrypted files (coupons). Thus, once the client system has decrypted and displayed the coupon data, it would have been obvious that the unencrypted file could now be printed. Therefore, it would have been obvious to decrypt and print the coupon being selected by the Philyaw system. One would have been motivated to decrypt and print the coupon in order to allow the user of the client system to redeem the coupons at a “brick-and-mortar” store.

Claims 14 and 39: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3 and 28 above. Both Schreiber and Philyaw also disclose displaying at least a portion of the advertisement (coupon) to the user of the client device (Schreiber, col 28, lines 50-52) (Philyaw, col 19, line 65 – col 20, line 3).

Claims 15 and 40: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 14 and 39 above, and Mankoff further discloses selecting an advertisement (advertising impression) in

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which the coupons are arranged in categories and subcategories and the selection of the coupon is based on the matching category/subcategory (col 4, lines 42-46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the available coupons and advertisements in Schreiber and Philyaw into categories and subcategories and to make the selection from the appropriate category/subcategory. One would have been motivated to sort the advertisements and coupons in this manner in order to facilitate the locating and retrieval of the desired coupons/advertisements.

Claims 16 and 41: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 2 and 28 above, and Mankoff further discloses tracking the user's actions on the client device and maintaining a database of coupons viewed, selected, and redeemed by the user (col 2, lines 11-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to track and store the user's actions on the client device in Schreiber and Philyaw. One would have been motivated to track the user's actions in this manner in order to allow the advertiser/coupon issuer to better assess the effectiveness of their marketing campaign.

Claim 17 and 42: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 16 and 41, and Mankoff further discloses determining the identity of the advertiser/coupon provider (col 1, lines 55-58 and col 3, lines 55-66). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the

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identity of the advertiser/coupon issuer in Schreiber and Philyaw. One would have been motivated to identify the advertiser/coupon issuer in order to determine to whom the marketing fees would be charged and to enable the system to provide feedback to the marketer.

Claims 18 and 43: Schreiber, Mankoff, and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 16 and 41 above, and Schreiber further discloses encrypting the files prior to transmission across unsecure networks. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the user event (history) files in Philyaw. One would have been motivated to encrypt thus data in order to prevent unauthorized disclosure to other users of the client device (e.g. other family members or co-workers).

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The Examiner notes that the Applicant's arguments against the Official Notices used in the rejections of Claims 9-10 and 34-35 and of Claims 12 and 37 do not adequately traverse the Official Notices nor provide arguments that the features are not well known. Instead, the Applicant has merely requested references in support of these well known features. To adequately traverse an assertion of being well known (Official Notice) an applicant must specifically point out the supposed errors in the examiner's

action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art (See 37 CFR 1.104(c)(2). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241). Nevertheless, the Examiner has provided excerpts from pertinent textbooks published prior to the time of the invention to show that these features were well known in the art.

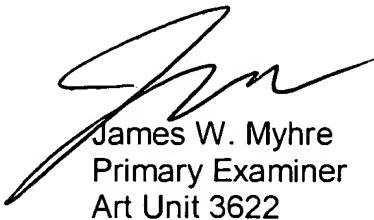
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
May 10, 2004


James W. Myhre
Primary Examiner
Art Unit 3622